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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* SWAMINATHAN CHANDRASEKARAN,  
LAKSHMINARAYANAN KRISHNAMURTHY, and  
CHRISTOPHER L. WALK

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Appeal 2016-001362  
Application 13/423,343<sup>1</sup>  
Technology Center 3600

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Before CARLA M. KRIVAK, HUNG H. BUI, and SHARON FENICK,  
*Administrative Patent Judges.*

BUI, *Administrative Patent Judge.*

DECISION ON APPEAL

Appellants seek our review under 35 U.S.C. § 134(a) of the Examiner's Final Rejection of claims 1–5, 8–13, 15–21, and 24–29, which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.<sup>2</sup>

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<sup>1</sup> According to Appellants, the Real Party in Interest is International Business Machines Corporation. App. Br. 1.

<sup>2</sup> Our Decision refers to Appellants' Appeal Brief filed July 1, 2015 ("App. Br."); Reply Brief filed November 5, 2015 ("Reply Br."); Examiner's Answer mailed September 18, 2015 ("Ans."); Final Office Action mailed

## STATEMENT OF THE CASE

Appellants' invention relates to "a mechanism by which software may be provided to assist in setting up processes for measuring and/or monitoring progress relative to organizational objectives and goals." Spec. ¶ 1. Appellants' Specification states "example embodiments provide a platform configured to be employed by an organization in order to enable the organization to step through the development of a personalizable performance indicators for use in a BPM [Business Process Management] tool that can track progress relative to goals, KPIs [key performance indicators] and/or the like that are relevant to the organization by using a plurality of glossaries." Spec. ¶ 13.

Claims 1, 9, and 17 are independent. Claim 1 is illustrative of Appellants' invention and is reproduced below:

1. A method comprising:
  - providing at least one interface configured to receive an input specifying a business entity from an operator associated with an organization;
  - correlating, via processing circuitry, the business entity with one or more value chain characteristics from a value chain glossary based at least in part on type information associated with the business entity;
  - providing, via the at least one interface, a list of possible entity states selected from an entity state glossary based at least in part on the business entity or a selected value chain characteristic of the one or more value chain characteristics;
  - determining, via processing circuitry, a selected set of glossary terms correlated to at least one of the business entity,

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January 8, 2015 ("Final Act."); and original Specification filed March 19, 2012 ("Spec").

the selected value chain characteristic, or a selected entity state of the list of possible entity states from a plurality of glossaries, the glossaries relating to different performance indicator components associated with at least one of the business entity, the value chain characteristic, or business-specific entity state that are combinable to define a measurable performance indicator;

generating at least one performance indicator of the organization based on the selected set of glossary terms; and

exporting the at least one performance indicator of the organization to a business performance management tool,

wherein determining the selected set of glossary terms is performed based on operator selections associated with an at least partially pre-filled template provided to the operator for selection of the selected set of glossary terms, the at least partially pre-filled template being prefilled based on the type information associated with the business entity to define a set of context sensitive measurement concepts for one or more activities in which the business entity engages.

App. Br. 11–12 (Claims App’x).

*Examiner’s Rejection*

Claims 1–5, 8–13, 15–21, and 24–29 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject. Final Act. 9–10.

ANALYSIS

In rejecting claims 1–5, 8–13, 15–21, and 24–29 under 35 U.S.C. § 101, the Examiner finds these claims are directed to an abstract idea of “generating at least one performance indicator for an organization/business entity (via human user selections)” and specifically, to “the process of correlating the business entity with one or more value chain characteristics,

determining a set of glossary terms correlated to at least one of the business entity based on operator selections, and generating at least one performance indicator of the organization based on the selected glossary terms all describe the abstract idea.” Ans. 3.

The Examiner also finds Appellants’ claims “do not amount to significantly more than the abstract idea itself” because these claims (1) “fail to recite any improvements to another technology or technical field, improvements to the functioning of the computer itself, and/or meaningful limitations beyond generally linking the use of an abstract idea to a particular environment” and (2) recite a generic computer to perform “generic, well-understood and[sic] routing computer functions.” Final Act. 9–10. The Examiner therefore finds “providing, via at least one interface, a list of possible entity states” represents “data gathering activity” and “exporting the at least one performance indicator represents an insignificant post-solution output activity.” Ans. 4.

Appellants present several arguments against the § 101 rejection. App. Br. 4–10; Reply Br. 2–4. Appellants acknowledge claims 1, 9, and 17 provide “for method, apparatus, and computer program product for discovery and generation of organizational key performance indicators utilizing glossary repositories.” App. Br. 4. However, Appellants argue “the claims are not directed to non-statutory subject matter, e.g. an abstract idea” and “even if the claims were generally directed toward an abstract idea, the combination of elements of the claims are sufficient to ensure the claims amount to significantly more than the abstract idea itself.” App. Br. 4–5.

Second, Appellants argue “the claimed invention is necessarily rooted in computing technology in order to overcome a problem specifically arising in the realm of computing networks.” *Id.* at 5. Appellants assert the claim limitation “pre-filling of templates that provide glossary terms for KPI-related software” is “necessarily rooted in computer technology.” *Id.* at 8.

Third, Appellants argue “the invention does not merely relate to the functioning of a computer ‘employed only for its most basic function, the performance of repetitive calculations’” and does not “pre-empt every application related to any particular abstract idea.” *Id.* at 8.

Lastly, Appellants argue “the mere lack of a novelty or obviousness rejection under 35 USC § 102 or 103 is a strong indication that the claims, even if directed generally toward an abstract idea, amount to significantly more than the abstract idea itself.” *Id.* at 9.

We do not find Appellants’ arguments persuasive. Instead, we find Appellants’ arguments conclusory and the Examiner has provided a comprehensive response to Appellants’ arguments supported by a preponderance of evidence. Ans. 2–9. As such, we adopt the Examiner’s findings and explanations provided therein. *Id.* At the outset, we note the Supreme Court has long held that “laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347, 2354 (2014) (quoting *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013)). The “abstract ideas” category embodies the longstanding rule that an idea, by itself, is not patentable. *Alice*, 134 S. Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)).

In *Alice Corp. Pty. Ltd. v. CLS Bank Int’l*, 134 S. Ct. 2347 (2014), the Supreme Court reiterates an analytical two-step framework previously set forth in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012), “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts.” *Alice Corp.*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts,” such as an abstract idea. *Id.* If the claims are directed to a patent-ineligible concept, the second step in the analysis is to consider the elements of the claims “individually and ‘as an ordered combination’” to determine whether there are additional elements that “‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S. Ct. at 1298, 1297). In other words, the second step is to “search for an ‘inventive concept’—*i.e.*, an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (brackets in original) (quoting *Mayo*, 132 S. Ct. at 1294).

Turning to the first step of the *Alice* inquiry, we agree with the Examiner that Appellants’ method claim 1 and “computer-readable medium” claim 17 are directed to an abstract idea of “generating at least one performance indicator for an organization/business entity (via human user selections).” Ans. 3. All the steps recited in Appellants’ claims 1 and 17 including, for example: (i) “providing . . . a list of possible entity states selected from an entity state glossary based at least in part on the business entity [input from an operator] or a selected value chain characteristic [correlated with the business entity]; (ii) “determining . . . a selected set of

glossary terms” [based on operator selections associated with an at least partially pre-filled template]; (iii) “generating at least one performance indicator of the organization based on the selected set of glossary terms”; and (iv) “exporting the at least one performance indicator” are abstract processes of storing, collecting, and analyzing information of a specific content prior to output. Apparatus claim 9 recites similar limitations of claims 1 and 17 in the context of generic “processing circuitry” to process the recited functions. Nevertheless, information as such is intangible. *See Microsoft Corp. v. AT & T Corp.*, 550 U.S. 437, 451 n.12 (2007).

Information collection and analysis, including when limited to particular content, is within the realm of abstract ideas. *See, e.g., Elec. Power Grp. LLC v. Alstom S.A.*, 830 F.3d 1350, 1353 (Fed. Cir. 2016) (holding that “collecting information, analyzing it, and displaying certain results of the collection and analysis” are “a familiar class of claims ‘directed to’ a patent-ineligible concept”); *FairWarning IP, LLC v. Iatric Sys., Inc.*, 839 F.3d 1089, 1093–94 (Fed. Cir. 2016); *Internet Patents Corp. v. Active Network, Inc.*, 790 F.3d 1343, 1349 (Fed. Cir. 2015); *Digitech Image Techs., LLC v. Elecs. for Imaging, Inc.*, 758 F.3d 1344, 1351 (Fed. Cir. 2014); and *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366, 1370 (Fed. Cir. 2011).

Turning to the second step of the *Alice* inquiry, we find nothing in Appellants’ claims 1 and 17, and its corresponding apparatus claim 9, that adds anything “significantly more” to transform the abstract concept of collecting and analyzing information into a patent-eligible application. *Alice*, 134 S. Ct. at 2357. Appellants do not argue any of the steps recited in claims 1, 9, and 17 as individually inventive. None of Appellants’



arguments show that some inventive concept arises from the ordered combination of these steps, which, even if true, would be unpersuasive given that they are ordinary steps in data analysis and are recited in an ordinary order. Instead, Appellants' method claims 1, 9, and 17 simply recite "correlating the business entity with one or more value chain characteristics, determining a set of glossary terms correlated to at least one of the business entity based on operator selections, and generating at least one performance indicator of the organization based on the selected glossary terms," as recognized by the Examiner. Ans. 3.

Likewise, apparatus claim 9 simply incorporates generic components such as an "interface" and "processing circuitry" configured to perform the abstract concept of "correlating the business entity with one or more value chain characteristics, determining a set of glossary terms correlated to at least one of the business entity based on operator selections, and generating at least one performance indicator of the organization based on the selected glossary terms" i.e., collecting and analyzing information. *Id.*

As recognized by the Federal Circuit in *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 716 (Fed. Cir. 2014), *Bilski's* "machine-or-transformation" (MoT) test can also provide a "useful clue" in the second step of the *Alice* framework. See *In re Bilski*,<sup>3</sup> 545 F.3d 943, 954 (Fed. Cir.

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<sup>3</sup> In *In re Bilski*, the Federal Circuit adopted a "machine-or-transformation" (MoT) test to determine whether a process claim is eligible under 35 U.S.C. § 101. However, the Supreme Court held, in *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010), that the "MoT" test, while a "useful and important clue," is no longer the sole test for determining the patent-eligibility of process claims under § 101. Since *Bilski v. Kappos*, the Supreme Court has created a two-step framework in *Alice*, 134 S. Ct. at 2354 to address whether a claim falls outside of § 101, which we discuss *infra*.

2008) (en banc). Under *Bilski*'s MoT test, a claimed process can be considered patent-eligible under § 101 if: (1) "it is tied to a particular machine or apparatus"; or (2) "it transforms a particular article into a different state or thing." *Bilski*, 545 F.3d at 954 (citing *Gottschalk*, 409 U.S. at 70, 93 S. Ct. 253). However, Appellants' method claims 1 and 20 and its corresponding system claim 13 are neither sufficiently "tied to a particular machine or apparatus" nor involved in any type of transformation of any particular article.<sup>4</sup>

Limiting such an abstract concept of "generating at least one performance indicator for an organization/business entity (via human user selections)" to generic components such as an "interface" and "processing circuitry" recited in Appellants' apparatus claim 9 does not make the abstract concept patent-eligible under 35 U.S.C. § 101. Ans. 3. As recognized by the Supreme Court, "the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention." *See Alice*, 134 S. Ct. at 2359 (concluding claims "simply instruct[ing] the practitioner to implement the abstract idea of intermediated settlement on a generic computer" not patent eligible); *see also Ultramercial*, 772 F.3d at 715–16 (claims merely reciting the abstract idea of using advertising as currency as applied to particular technological environment of the Internet is not patent eligible); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344–45 (Fed. Cir. 2013) (claims reciting "generalized software components arranged to

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<sup>4</sup> *Alice* also confirmed that if a patent's systems claims are no different in substance from its method claims, they will rise and fall together. 134 S. Ct. at 2360. The same is true of the *Alice* patent's media claims. *Id.*

implement an abstract concept [of generating insurance-policy-related tasks based on rules to be completed upon the occurrence of an event] on a computer” is not patent eligible); and *Dealertrack, Inc. v. Huber*, 674 F.3d 1315, 1333–34 (Fed. Cir. 2012) (“[s]imply adding a ‘computer aided’ limitation to a claim covering an abstract concept, without more, is insufficient to render [a] claim patent eligible” (internal citation omitted)).

With respect to Appellants’ argument regarding the absence of “novelty and non-obviousness” analysis, we recognize that claim limitations found to be novel and/or nonobvious can affect a patent-eligibility determination. *Cf. Ariosa Diagnostics, Inc., v. Sequenom, Inc.*, 788 F.3d 1371 (Fed. Cir. 2015) (“For process claims that encompass natural phenomenon, the process steps are the additional features that must be new and useful.”) However, a finding of novelty or nonobviousness does not necessarily lead to the conclusion that subject matter is patentable eligible. “Groundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2117 (2013)

“Indeed, “[t]he ‘novelty’ of any element or steps in a process, or even of the process itself, is of no relevance in determining whether the subject matter of a claim falls within the § 101 categories of possibly patentable subject matter.” *Diamond v. Diehr*, 450 U.S. 175, 188–89 (1981) (emphasis added); see also *Mayo*, 132 S. Ct. at 1303–04 (rejecting “the Government’s invitation to substitute §§ 102, 103, and 112 inquiries for the better established inquiry under § 101”). Here, the jury’s general finding that Symantec did not prove by clear and convincing evidence that three particular prior art references do not disclose all the limitations of or render obvious the asserted claims does not resolve the question of whether the claims embody an inventive concept at the second step of *Mayo/Alice*.”

*Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1315 (Fed. Cir. 2016).

Nor does a finding of obviousness necessarily lead to the conclusion that subject matter is patentable ineligible. *See also Rapid Litig. Mgmt. Ltd. v. CellzDirect, Inc.*, 827 F.3d 1042, 1050 (Fed. Cir. 2016) (“That each of the claims' individual steps (freezing, thawing, and separating) were known independently in the art does not make the claim unpatentable.”) “[P]atent-eligibility does not turn on ease of execution or obviousness of application. Those are questions that are examined under separate provisions of the Patent Act.” *Id.* at 1052 (citing *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 566 U.S. 66, 90 (2012)).

The question in step two of the *Alice* framework is not whether an additional feature is novel, but whether the implementation of the abstract idea involved “more than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass’n*, 776 F.3d 1343, 1347–48 (quoting *Alice*, 134 S. Ct. at 2359). Appellants have not shown the novel features transform the abstract idea into patent-eligible subject matter.

Lastly, we note Appellants’ claims 1–5, 8–13, 15–21, and 24–29 are neither rooted in computer technology as outlined in *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014), nor do they seek to improve any type of computer capabilities, such as a “self-referential table for a computer database” outlined in *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336–37 (Fed. Cir. 2016). Instead, Appellants’ claims 1–5, 8–

13, 15–21, and 24–29 simply recite an abstract concept of “generating at least one performance indicator for an organization/business entity (via human user selections).”

Because Appellants’ claims 1, 9, and 17 are directed to a patent-ineligible abstract concept and do not recite something “significantly more” under the second prong of the *Alice* analysis, we sustain the Examiner’s rejection of these claims as well as respective dependent claims 2–5, 8, 10–13, 15–16, 18–21, and 24–29 under 35 U.S.C. § 101 as being directed to non-statutory subject matter in light of *Alice* and its progeny.

#### CONCLUSION

On the record before us, we conclude Appellants have not demonstrated the Examiner erred in rejecting claims 1–5, 8–13, 15–21, and 24–29 under 35 U.S.C. § 101.

#### DECISION

As such, we AFFIRM the Examiner’s final rejection of claims 1–5, 8–13, 15–21, and 24–29.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED